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Vincent Tassinari

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application for:

Mohammad FAISAL

Serial No.: 09/742,809

Filing Date: 12/19/2000

For: AUTOMATED EXTENSION FOR
GENERATION OF CROSS REFERENCES
IN A KNOWLEDGE BASE

examiner: Neveen ABEL JALIL

Phone: (703) 305-8114

Group Art Unit: 7301 (2175)

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This Petition asserts that the examiner's answer (Paper No. 14) contains impermissible new grounds of rejection (see 37 CFR 1.193(b)(1) and MPEP 1208.01) and impermissibly reassert all the rejections which were previously overcome by Petitioner during prosecution.

Accordingly, Petitioner requests that the entry or reassertion of the Wical '718 § 102(b) grounds

5 of rejection of claims 1-15 be prohibited.

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PTO-854 (07-03)

130-07-10

**I. SINCE THE REJECTION OF CLAIMS 1-15 IN THE EXAMINER ANSWER IS A
NEW GROUND OF REJECTION, 37 CFR 1.193(a)(2) PROHIBITS THE ENTRY
OF THE REJECTION OF CLAIMS 1-15 IN THE EXAMINER ANSWER**

37 CFR 1.193(a)(2) prohibits the examiner from entering a new ground of rejection in an

5 examiner's answer. Under MPEP 1208.01, a new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. MPEP 1208.01

Co-pending with this petition is an appeal from the non-final rejection set forth in the
10 third Office action (Paper No. 12). In Paper No. 12, all pending claims (Claims 1-15) were rejected under 35 U.S.C. § 102(b) as being anticipated only by Wical (US Patent No. 5,930,788) (Wical '788). In the examiner's answer (Paper No. 14), the examiner cited a different patent by Wical (US Patent No. 5,953,718) (Wical '718). Since Wical '718 was not cited in Paper No. 12, Wical '718 is a new prior art reference cited for the first time in an examiner's answer.

15 The examiner relied only on Wical '718 in the examiner's answer to support a 35 U.S.C. § 102(b) against all pending claims. Since the citation of Wical '718 is necessary to support the § 102(b) rejection in the examiner's answer, it must be included in the statement of rejection, which is considered to introduce a new ground of rejection.

Because 37 CFR 1.193(a)(2) prohibits the examiner from entering a new ground of
20 rejection in an examiner's answer, Petitioner requests that the examiner be prohibited from entering any grounds of rejection based on Wical '718.

II. SINCE THE WICAL '718 § 102(b) REJECTION OF CLAIMS 1-15 IN THE EXAMINER ANSWER WAS PREVIOUSLY OVERCOME BY PETITIONER AND WITHDRAWN BY THE EXAMINER, THE EXAMINER IS PROHIBITED FROM REASSERTING ANY GROUNDS OF REJECTION BASED ON WICAL '718.

5 If an examiner reasserts rejections in an examiner's answer that were previously overcome by Petitioner during prosecution, Petitioner may petition the commissioner to prevent such reassertion. See Ex Parte Papu D. Maniar, 1996 WL 1749256, Bd.Pat.App & Interf. Appeal No. 96-2697 (1996) (Application 08/215,170) (We are sympathetic to Petitioner's frustration caused 10 by the course of prosecution in this application. Arguments that the examiner should not be permitted to reassert all the rejections that were previously overcome by Petitioner during prosecution may ^{be} raised by petition.)

Under MPEP § 707.07(e), every point in the prior action of an examiner that is still applicable must be repeated or referred to, to prevent the implied waiver of the requirement. See 15 Ex Parte Edward Fu, Ratana K. Chaudhuri and Kolazi S. Narayanan, 1995 WL 1696771, Bd.Pat.App & Interf. Appeal No. 95-2233 (1995) (Application 07/978,014) ("The only reasonable interpretation which these facts permit is that the examiner dropped all rejections set forth in the Final Rejection except the rejections specifically referred to in the examiner's answer. See Paperless Accounting, Inc. V. Bay Area Rapid Transit System, 804 F.2d 659, 663 (Fed. Cir. 20 1986)"). See also, Ex Parte Howard W. Long, Dec'd, 1997 WL 33107232, FN2, Bd.Pat.App & Interf. Appeal No. 1997-2277, FN2 (1997) (Application 08/462,814) (The examiner does not repeat or refer to the rejection in the examiner's answer. Therefore, as a matter of standard procedure, the previously entered rejection of claim 6 has been withdrawn). And see, Ex Parte Robert F. Garfield and Krosto Chawalisz 2004 WL 77127, Bd.Pat.App & Interf. Appeal No.

2001-0982 (2004) (Application 08/310,950) ("Since this other ground of rejection was not included in the examiner's answer, we assume that this ground of rejection has been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)").

1. On March 21, 2003, the examiner entered a final rejection of claims 1-15 under 35

5 U.S.C. § 102(b) as being anticipated by Wical (US Patent No. 5,953,718) (Wical '718) (Paper No. 6) (the second Office action).

2. On September 9, 2003, Petitioner filed an appeal brief.

3. On December 19, 2003, the examiner reopened prosecution in view of the arguments in Petitioner's September 9, 2003 appeal brief to enter a new ground of rejection
10 (Paper No. 12) (the third rejection). In Paper No. 12, the examiner rejected claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by Wical (US Patent No. 5,930,788) (Wical '788). The examiner failed to repeat or sufficiently refer to the rejections of Paper No. 6 (the second Office action) in this Paper No. 12 (the third Office action).

4. On April 21, 2004, Petitioner exercised its option under 37 CFR 1.193(b)(2)(ii) to
15 reinstate the appeal and filed a supplemental appeal brief (Paper No. 13) in response to the December 19, 2003 non-final rejection.

5. On July 26, 2004, the examiner mailed an examiner's answer (Paper No. 14).

As noted above, the examiner failed to repeat or sufficiently refer to the rejections of Paper No. 6 (the second Office action) in Paper No. 12 (the third Office action). Since the
20 examiner failed to repeat or refer to in the third Office action every point in the second Office action that is still applicable, the examiner withdrew all rejections set forth in the second Office action (Paper No. 6). MPEP § 707.07(e). In particular, the examiner withdrew all rejections based on Wical '718 and issued a new ground of rejection. The examiner explained under item 1 of Paper No. 12 (the third Office action) that this was in view of petitioner's appeal brief filed on

12-September-2003. In other words, in response to Petitioner's appeal brief arguments overcoming the Wical '718 § 102(b) Rejection, the examiner Withdrew the Wical '718 § 102(b) Rejection.

Because the examiner is prohibiting from reasserting any rejection that was previously 5 overcome by Petitioner during prosecution, Petitioner requests that the examiner be prohibited from entering any grounds of rejection based on Wical '718.

III. REQUEST

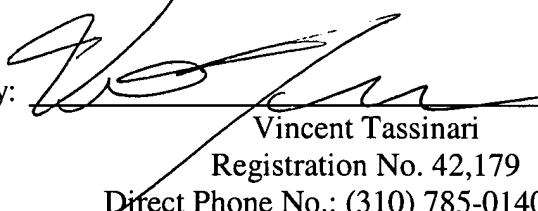
In view of the above, Petitioner requests that the entry or reassertion of the Wical '718 § 102(b) grounds of rejection of claims 1-15 be prohibited.

Dated: August 24, 2004

Respectfully submitted,

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